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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,389	04/13/2001	Jerrold E. Franklin	3737.02-1	3452
8156	7590	11/15/2006	EXAMINER CANTELMO, GREGG	
JOHN P. O'BANION O'BANION & RITCHEY LLP 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			ART UNIT 1745	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

09/834,389

Applicant(s)

FRANKLIN ET AL.

Examiner

Gregg Cantelmo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18, 20 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18, 20 and 22-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/1/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 1, 2006 has been entered.

Response to Amendment

2. In response to the amendment received September 1, 2006:
- a. Claims 2-18, 20 and 22-37 are pending;
 - b. The previous drawing objections and 112 rejections stand;
 - c. The previous obviousness-type double patenting rejection is withdrawn in light of the abandonment U.S. patent application serial No. 10/369,257.

Information Disclosure Statement

3. The information disclosure statement filed September 1, 2006 has been placed in the application file and the information referred to therein has been considered as to the merits.

Drawings

4. The drawings were received on September 1, 2006. These drawings are not approved since they are held to introduce new matter into the instant application.

The separator being bent over or crimped *over the edge of said flexible membrane assembly and seal* constitutes new matter which cannot be entered.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the separator being bent over, or rolled and/or crimped over the sealed edge portions of said flexible membrane assembly must be shown or the feature(s) canceled from the claim(s). No new matter can be entered. The separator is not shown nor disclosed as being provided over the edge of the MEA and the amendment to the claims still fails to overcome this arrangement.

Claim Interpretation

Upon further consideration clarification is requested with respect to the claimed separator plate being "flexible or ridged". The latter term is unclear as to whether or not the separator is a ridged separator or intended to be described as a rigid separator. Since the first descriptive term is to a flexible separator it may have been Applicant's intent for the latter term to be rigid (i.e. not flexible) and not ridged. Clarification is respectfully requested.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims as amended now recite that the edge portion of the separator plate is rolled, bent over, or rolled and/or crimped *over the sealed edge portions of said flexible membrane*. There is no clear support for this arrangement as recited in the amendment and therefore raises new matter.

The only statement in the original disclosure as to the relationship between the separator and MEA is that the separator is bent, rolled, or crimped "against" the MEA (page 11, ll. 8-11). The specification does not define the degree or extent of how exactly the separator is bent, rolled or crimped "against" the MEA and absent such cannot be held to sufficiently teach the particular arrangement as defined in claims 2-37 (in particular, the specification lacks sufficient description to support the amendment to claims 2 and 23 as to the separator being bent over or crimped *over the edge of said flexible membrane assembly*). Further the drawings fail to show this arrangement and lack support for this description since the figures showing the bent separator fail to include the MEA and thus lack sufficient disclosure to show the relationship defined in claims 2-37 such as the edge portion of the flexible or ridged bipolar separator plate being bent over, or rolled and/or crimped over the said sealed edge portions of said flexible membrane electrode assembly to prevent the release of reactants from the fuel cell.

In light of the previous 112 rejections and drawing objections Applicant appears to have both amended the claims and drawings concurrently to overcome this rejection

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however both amendments are not held to be clearly disclosed by the original specification. While the Examiner appreciates Applicant's intent to overcome these outstanding rejections, the manner in which Applicant is attempting to overcome these issues is held to introduce new matter into the original application.

Thus the claims as amended raise new matter issues.

Claims 2-37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for bending, rolling or crimping the separator against the MEA, does not reasonably provide enablement for the separator being bent, rolled over or crimped *over the edge of said flexible membrane assembly*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. See the previous item for further details.

Response to Amendment

7. The amendment to the claims is not sufficient to overcome the previous 112 rejections and drawing objections. The modified claims still recite the plate being bent over or crimped *over the sealed edge portions of said flexible membrane*. As discussed above and in the previous office action, the original disclosure does not have clear support for this arrangement. The combination of amendments to the figures and claims is not reasonably and clearly supported by the original disclosure and thus is still held to constitute new matter.

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Reliance upon the proposed replacement drawings is not persuasive since these drawings are not held to be supported by the original disclosure and also constitute new matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



gc
November 7, 2006

Gregg Cantelmo
Primary Examiner
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